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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,866	09/20/2000	Brian J. Brown	S63.2-9397	1548
490	7590	06/15/2004	EXAMINER	
VIDAS, ARRETT & STEINKRAUS, P.A. 6109 BLUE CIRCLE DRIVE SUITE 2000 MINNETONKA, MN 55343-9185			PREBILIC, PAUL B	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/666,866	<b>Applicant(s)</b> BROWN ET AL.	
	<b>Examiner</b> Paul B. Prebilio	<b>Art Unit</b> 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 36-45, 57, 67, 79, 80, 83, 84 and 89-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 57 is/are allowed.
- 6) ☒ Claim(s) 36-45, 67, 79, 80, 83, 84 and 89-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/12/2003</u> | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 15, 2004 has been entered.

***Claim Objections***

Claim 84 is objected to because of the following informalities: In claim 84, on line 3, the term "cylindrical" does not appear to be a proper adjective and could be replaced with ---cylindrically--- in order to overcome this objection. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36, 39-43, 79, 83, 84, and 89-96 are rejected under 35 U.S.C. 102(b) as being anticipated by Palmaz (US 5,102,417). Palmaz anticipates the claim language where the undulating bands as claimed are the straight segments of prosthesis (70) of Palmaz (see Figures 9 and 10). These straight segments are attached at both ends to another strut either the location of element (77) or at other ends of that strut. The

Art Unit: 3738

connecting elements as claimed are met by the spiral connector members (102) of Palmaz (see column 12, line 33 to column 13, line 22).

With regard to claim 84, Palmaz has slots (82) and openings (the other holes of the stent) such that the claim language is read upon by Palmaz's structure.

With regard to claims 40 and 94, although the stent of Palmaz is not disclosed as self-expanding, the construction and arrangement of the stent is such that a self-expanding material could be used to make this stent.

With regard to claims 42 and 92, the stent of Palmaz is a shape memory material or alloy because it keeps the shape given to it by the balloon; see column 7, lines 3-18.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36, 39-45, 67, 79, 84, and 89-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al (EP 0540290) in view of Palmaz (US 5,102,417). Lau meets the claim language where the undulating bands as claimed are elements (12) of Lau and the connecting elements as claimed are elements (13) of Lau; see Figure 11 and column 6, lines 34-49 and column 7, line 23 to column 8, line 1. Lau et al fails to disclose the interconnector elements that are circumferentially and longitudinally offset as claimed. However, Palmaz is cited to show that it had been known to make connectors for adjacent stent segments offset in this way; see Figure 7-10 and the Col. 11, line 35 to Col. 13, line 18. Hence, it is the Examiner's position that it would have

been obvious to make the connectors of Lau et al offset circumferentially and with respect to the longitudinal axis for the same reasons that Palmaz did the same and so that better radial support for the vessel is provided in between stent segments then with a longitudinally aligned connector.

With regard to claims 40-42, Applicants are directed to column 1, lines 22-35, column 2, lines 40-56 and column 7, lines 22-58 of Lau.

Claims 37, 38, and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al and Palmaz as applied to claims 36, 39-45, 67, 79, 84, and 89-96 above, and further in view of Lam et al (US 5,725,572). Lau et al fails to disclose varying the strut length on the proximal and/or distal segment as claimed. However, Lam et al teaches that it was known to make the struts on the proximal and distal segments longer where there are no connectors; see especially Figure 1A. Hence, it is the Examiner's position that it would have been obvious to make the struts of Lau et al longer at the connection points for the same reasons Lam et al does the same and in order to space adjacent segments a greater distance from each other and avoid contact thereof during longitudinal or axial flexing.

### ***Response to Arguments***

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection. The rejections have been changed to include more explanation as to how they are being applied. For this reason, the traversal of the March 15, 2004 response has been addressed within the respective rejections.

Art Unit: 3738

***Allowable Subject Matter***

Claim 57 allowable over the prior art of record.

***Conclusion***

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic  
Primary Examiner  
Art Unit 3738